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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,823	01/04/2001	Akira Arai	9319A-000182	3470

7590

02/26/2002

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EXAMINER

SHEEHAN, JOHN P

ART UNIT

PAPER NUMBER

174

10

DATE MAILED: 02/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/754,823

Applicant(s)

ARAI ET AL.

Examiner

John P. Sheehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 13 to 17 and 19 to 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 12 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1 to 12 and 18 in Paper No. 10 is acknowledged. The traversal is on the ground(s) that both groups of claims are sufficiently related that an undue burden would not be placed upon the Examiner to maintain both groups of claims in a single application. This is not found persuasive because applicants have not controverted the Examiner's basis for the restriction, that the combination claims 13 to 17 and 19 to 26 do not require the particulars of the subcombination recited in claims 1 to 12 and 18. Further, in addition to the further searching referred to in the statement of the Restriction Requirement the examination of both the combination and subcombination claims in a single application would require additional analysis of the prior art, formulation of rejections, evaluation of applicants' arguments and consideration of issues of patentability.

The requirement is still deemed proper and is therefore made FINAL.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

3. Claim 14 is objected to because of the following informalities:

I. Claim 18 is objected to in that it is dependent on nonelected claim

13.

4. Applicant is advised that should claim 1 be found allowable, claim 4 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 to 12 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

I. The meaning of the phrase, "one *kind of* rare-earth element" (claim 1, lines 2 and 3; claim 3, lines 2 and 3; and claim 18, lines 3 and 4, emphasis added by the Examiner), is not clear in the context of the claims. The use of the word "kind" is not conventional Markush language. The use of "kind" renders the

claims indefinite in that it is not clear what is encompassed by the Markush group and what rare-earth elements can be selected from the Markush group. For example, if two rare-earth elements are selected from the Markush group must each be a different "kind"? Further, it is not clear what is meant by "kind" in the context of the claims. This rejection can be obviated by deleting the phrase "kind of" from the claim.

II. In claim 1, line 9; claim 2, line 4; claim 3, line 9; claim 4, line 3 and claim 5, line 3, "it" lacks a clear antecedent.

III. In claim 1, lines 11, 14 and 14; claim 2, line 5; claim 3, line 10; and claim 4, line 4, the meaning of the term, "the room temperature" is not clear. In view of the use of the word, "the" it is not clear that the phrase refers to room temperature as generally used in science and technology but rather to the temperature of a specific unspecified room. This rejection can be obviated by deleting each occurrence of "the".

IV. In claims 7 and 8, line 2, "its" lacks a clear antecedent.

V. In claim 9, line 3, the meaning of the phrase, "by quenching the alloy of a molten state" is not clear. What does this phrase mean?

VI. In claim 10, line 3, the meaning of the phrase, "by using a cooling roll" is not clear. What does this phrase mean? How is the cooling rolled used?

VII. In claims 9, 10 and 11, line 2, the use of the word, "is" is indefinite. It is not clear whether the claim is directed to a powder that has actually been treated by the subsequently recited process step or whether the claim is directed to a

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powder that is merely capable of being made by the subsequently recited process step. This rejection can be obviated by amending the claim language to recite that the powder has actually been treated according to the subsequently recited process step. For example in claim 10, line 1, delete "which is" and insert --having been--.

VIII. In claim 18, line 1, "The isotropic bonded magnet" lacks a clear antecedent.

Claim Rejections - 35 USC § 102/103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 to 12 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over each of Panchanathan (US

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Patent No. 5,725,792, cited By applicants in the IDS submitted January 4, 2001) or Schultz et al. (Schultz, cited By applicants in the IDS submitted January 4, 2001).

10. Each of these references teaches specific example alloys having compositions that are encompassed by the alloy composition recited in the instant claims and bonded magnets made there from (Panchanathan, column 3, Example 2, Alloy N and Schultz, the Abstract, line 6, page 200, Figure , page 201, line 16, page 203, Table 2, the first 8 alloys and Figures 6 to 8, and Page 204, Table 3). Each of the references teaches that the disclosed alloys are made by melt spinning a melt of the alloy (Panchanathan, column 2, Example 1 and Schultz, page 199, under the heading Experimental) which is the same process used to make the instantly claimed alloys (see page 15 of the instant application).

11. The claims and the references differ in that the references are silent with respect to the magnetic properties recited in the instant claims and the presence of hard and soft magnetic phases.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the alloys taught by the references have compositions that are encompassed by the instant claims and are made by a process which is similar to, if not the same as, applicants' process of making the instantly claimed alloy. In view of this, the alloys taught by the references would be expected to possess all the same properties as recited in the instant claims, In re Best, 195 USPQ, 430 and MPEP 2112.01.

"Where the claimed and prior art products are identical

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or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' *In re Spada*, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 195 USPQ 430, 433 (CCPA 1977)." see MPEP 2112.01.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 to 12 and 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 10 and 14 of copending Application No. 09/754,463. Although the conflicting claims are not identical, they are not patentably distinct from each other because the two sets of claims are drawn to a magnetic alloy powder having the exact same alloy composition consisting of a soft magnetic phase and a hard magnetic phase. Each set of claims

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recite different properties (not different values of the same properties but totally different properties) of a bonded magnet made from the claimed powder.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the claimed alloys in these two sets of claims are the same and therefore would be expected to possess all the same properties, *In re Best*, 195 USPQ, 430 and MPEP 2112.01.

“Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ *In re Spada*, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).” see MPEP 2112.01.

13. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

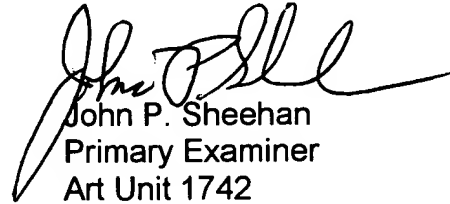
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (703) 308-3861. The examiner can normally be reached on T-F (6:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Roy King can be reached on (703) 308-1146. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703) 305-3599 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



John P. Sheehan
Primary Examiner
Art Unit 1742

jps
February 20, 2002